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**REMARKS****Reissue Application**

The Office Action states that the original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, **must** be received before this reissue application can be allowed. See 37 CFR 1.178

**Applicant's Response**

The original patent will be surrendered before the prosecution of the present case comes to an end.

**Interview Summary**

Applicant appreciates the telephone interview granted by the Examiner to Applicant's undersigned attorney. In that interview, the below remarks were discussed, which the Examiner indicated should be sufficient to overcome the outstanding rejection of claims 30 and 31 under 35 USC §135(b) and invoke an interference.

**Claim Rejections under 35 USC 102**

Claims 1, 6-8, 14, 15, 21-23, 25 and 29-31 were rejected under 35 USC §102(e) as being clearly anticipated by Greenfield et al (US Patent Number 5,687, 799).

**Applicant's Response**

The above-identified application was originally filed on October 19, 1995 as the provisional patent application Serial No. 60/005,639 ('639). The '799 Greenfield et al patent was filed on August 12, 1996. Thus, the above-identified application has a priority filing date that is almost a year before the filing date of the '799 patent. In addition, when viewed in total (both the entire specification and drawings), it is submitted that the parent '639 provisional application provides, either expressly and/or inherently, §112 support for all of these rejected claims. For example, the '639 specification discloses:

Broadly, the present invention provides two basic systems for guarding or protecting against refuse wrapping around the wheel axle. In one aspect of the present invention, the inner circumferential row of cleats on each compactor wheel is removed. Depending on how close they are to the inner edge of the wheel, the inner circumferential row of cleats tend to push refuse toward the wheel's axle. By removing the inner

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circumferential row of cleats or moving the inner row of cleats away from the inner edge of the wheel wrapper, the refuse is less likely to be pushed toward the axle and end up wrapped around the axle. Alternatively, instead of actually removing or moving the inner circumferential row of cleats, the same results may effectively be obtained by extending the inner edge of the wheel wrapper toward the compaction machine. It may also be possible to obtain the desired results by doing a combination of moving the inner circumferential row of cleats and extending the inner edge of the wheel wrapper.

In an effort to effectively move the inner circumferential row of cleats away from the inner edge of the wheel wrapper, it may be desirable to extend the outer edge of the wrapper and shift all of the circumferential rows of cleats away from the inner edge of the wheel wrapper. It may also be desirable to extend both the inner edge and the outer edge of the wheel wrapper to provide the room needed to move the cleats a sufficient distance away from the axle (i.e., the inner edge of the wrapper) without having to remove the inner row of cleats. Especially for narrower compactor wheels (i.e., those wheels that have a width of about 35 inches or smaller), it is best not to remove the inner circumferential row of cleats, if possible. The narrower compactor wheels typically have only three circumferential rows of cleats. The wider compactor wheels (i.e., those wheels having a width of greater than about 35 inches) typically have four to five circumferential rows of cleats and are less affected by the loss of the inner row of cleats.

In another aspect of the present invention, each compactor wheel can include a circumferential barrier which extends radially out from the wheel wrapper near its inner edge. This barrier is made of a suitable material, such as steel. The barrier can comprise a single ring shaped wall, or a series of spaced fins or plates, mounted circumferentially around the wheel wrapper near its inner edge and extending radially outward from the axis of rotation of the wheel. It may be desirable for the ring or fins to be flared near the wheel wrapper for support or supported or reinforced with a separate buttressing structure. (emphasis added)

Therefore, because the parent '639 provisional application discloses substantially the same subject matter and was filed earlier, the Greenfield et al ('799) patent is not §102(e) prior art to the present invention. Accordingly, it is submitted that the above §102(e) rejection was improper and should be withdrawn.

### Interference

Claims 30 and 31 were rejected under 35 USC §135(b) as not being made prior to one year from the date on which U.S. Patent No. 5,687,799 ('799) was granted. The Office Action further states:

See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997) where the Court held that the application of 35 USC 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections.

Please see MPEP 2306 and MPEP 1449.02.

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Applicant's Response

MPEP §2304.02(c), under the heading "II. COMPLIANCE WITH 35 U.S.C. 135(b)", states:

If an application claim interferes with a claim of a patent or published application, and the claim was added to the application by an amendment filed more than one year after issuance of the patent, ... then under the provisions of 35 U.S.C. 135(b), an interference will not be declared unless at least one of the claims which were in the application, or in a parent application, prior to expiration of the one-year period was for "substantially the same subject matter" as at least one of the claims of the patent. (emphasis added)

It is submitted that at least one of the claims that were in the present parent non-provisional patent application prior to the expiration of the 1-year period was for "substantially the same subject matter" as at least one of the claims of the '799 Greenfield et al patent. In particular, for example, both the present parent application and the '799 patent include claims directed to a compactor wheel that includes at least one or both of two basic systems for guarding or protecting against refuse wrapping around the wheel axle. One is a cleat-free area adjacent the inner edge of the wheel, and the other is a circumferential barrier which extends radially out from the face of the wheel near its inner edge.

Therefore, it is submitted that the rejection of claims 30 and 31 under 35 USC §135(b) was improper, pursuant to MPEP §2304.02(c), and should be withdrawn. Accordingly, it is requested that the Examiner initiate an interference proceeding between the present case and the '799 patent based, at least in part, on claims 30 and 31.

Allowable Subject Matter

In the Office Action, claim 2-5, 9-13 and 16-20 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's Response

Applicant appreciates the finding of allowable subject matter in the noted claims. However, in light of the above remarks against the outstanding rejections, Applicant does not believe that the amendments to the claims proposed in the Office Action are necessary and,

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therefore, respectfully declines to amend the claims as proposed.

CONCLUSION

For the foregoing reasons, Applicant respectfully submits that claims 1-23, 25, and 29-31 are in condition for allowance. In addition, claims 1-10 in the '799 patent are directed to subject matter that is patentably indistinct from at least the present claims 30 and 31. An interference based on the proposed counts is therefore appropriate.

Respectfully submitted,

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